

ESTTA Tracking number: **ESTTA632815**

Filing date: **10/14/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212640
Party	Plaintiff Buffets, Inc.
Correspondence Address	RYAN R PALMER MONROE MOXNESS BERG PA 7760 FRANCE AVENUE SOUTH, SUITE 700 MINNEAPOLIS, MN 55435 UNITED STATES trademarks@mmblawfirm.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Ryan R. Palmer
Filer's e-mail	trademark@mmblawfirm.com
Signature	/Ryan R. Palmer/
Date	10/14/2014
Attachments	Buffets Opposer's Motion for Leave to Amend Notice of Opposition.pdf(479714 bytes )

Buffets, Inc.,	)	Opposition No. 91212640
	)	
Opposer,	)	
	)	
v.	)	<b><u>OPPOSER BUFFETS, INC.'S MOTION</u></b>
	)	<b><u>FOR LEAVE TO AMEND NOTICE OF</u></b>
STARTS CC, INC.,	)	<b><u>OPPOSITION</u></b>
	)	
Applicant.	)	
	)	

1) Opposer properly served and filed its Notice of Opposition in this matter on September 24, 2013.

3) Through the course of discovery, Opposer has obtained information indicating that Applicant has abandoned use of the Starts Mark.

4) On September 12, 2014, Opposer properly served and filed a Motion to Compel Discovery and for Sanctions (the “Motion to Compel”).

5) In its response to the Motion to Compel, Applicant has, among other things, alleged that certain of Opposer's discovery requests are improper, as abandonment of the Starts Mark was not pled.

6) Applicant's abandonment of the Starts Mark, if proven, is a proper ground for refusal of registration.

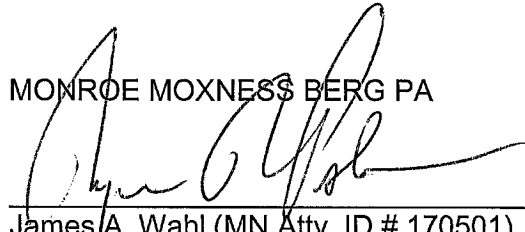
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8) Opposer accordingly requests leave to amend its Notice of Opposition, as set forth in the Amended Notice of Opposition attached hereto (Attachment 1).

WHEREFORE, Opposer's motion for leave to amend its notice of opposition should be granted as requested.

RESPECTFULLY SUBMITTED this 14<sup>th</sup> day of October, 2014.

MONROE MOXNESS BERG PA

A handwritten signature in black ink, appearing to read 'James A. Wahl', is written over a horizontal line.

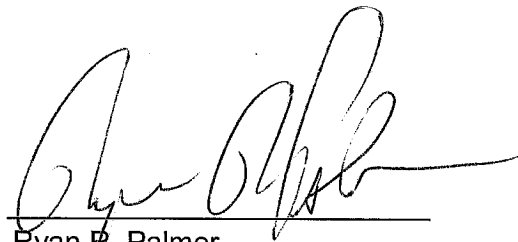
James A. Wahl (MN Atty. ID # 170501)  
Ryan R. Palmer (MN Atty. ID # 340650)  
7760 France Ave. S, Suite 700  
Minneapolis, Minnesota 55435  
Telephone: (952) 885-5999  
Facsimile: (952) 885-5969

### **CERTIFICATE OF SERVICE**

This is to certify that I have this day served a copy of OPPOSER BUFFETS, INC.'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION upon Applicant by depositing said copy in the United States Mail in a properly addressed envelope with adequate postage affixed thereon to:

Steven J. Nataupsky  
Knobbe, Martens, Olson & Bear, LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614

This 14<sup>th</sup> day of October, 2014.



Ryan R. Palmer

MONROE MOXNESS BERG PA  
7760 France Ave. S, Suite 700  
Minneapolis, MN 55435  
(952) 885-5999

## **ATTACHMENT 1**

**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

Buffets, Inc.,  
Opposer,

v.

Starts CC, Inc.,  
Applicant.

)  
) Serial No. 85802394  
) Mark: J.J. NORTH'S COUNTRY BUFFET  
) Opposition No. 91212640  
)  
) Publication Date: May 28, 2013  
)  
) **OPPOSER BUFFETS, INC.'S AMENDED**  
) **NOTICE OF OPPOSITION**  
)

In the matter of Application Serial Number 85802394 filed on December 13, 2012 and published in the Official Gazette on May 28, 2013 (the "Starts Application") by Starts CC, Inc. ("Starts" or "Applicant"), Opposer Buffets, Inc. ("Opposer"), 1020 Discovery Road, Eagan, Minnesota 55121, believes that it would be damaged by the registration of the mark in International Class 43 as shown in the Starts Application and therefore opposes registration of the Starts Application in International Class 43 on the following grounds:

1. Opposer is the operator of various restaurant businesses operated in the United States under the names COUNTRY BUFFET, OLD COUNTRY BUFFET, and related marks.
2. Opposer is the owner of trademark rights in the mark COUNTRY BUFFET and OLD COUNTRY BUFFET for restaurant services ("Opposer's Service Marks").
3. Opposer is the owner of the following United States Trademark Registrations for Opposer's Service Marks:

Registration Number	Filing Date	Mark
2987516	June 11, 2004	COUNTRY BUFFET
2149716	April 12, 1996	OLD COUNTRY BUFFET
2051197	September 16, 1994	OLD COUNTRY BUFFET
2051196	September 16, 1994	OLD COUNTRY BUFFET
2048119	September 16, 1994	OLD COUNTRY BUFFET
1423419	April 11, 1986	OLD COUNTRY BUFFET
1343558	July 11, 1984	OLD COUNTRY BUFFET

4. Opposer's first use and first use in commerce of its OLD COUNTRY BUFFET mark was at least as early as March 21, 1984, and Opposer's first use and first use in commerce of its COUNTRY BUFFET mark was at least as early as November 1992.

5. Opposer has expended substantial resources since at least as early as March 21, 1984 in advertising, promoting and popularizing Opposer's OLD COUNTRY BUFFET mark and in establishing and preserving the goodwill associated with Opposer's Service Marks.

6. Opposer has expended substantial resources since at least as early as November 1992 in advertising, promoting and popularizing Opposer's COUNTRY BUFFET mark and in establishing and preserving the goodwill associated with Opposer's Service Marks.

7. As a result of Opposer's longstanding and widespread use and registration of Opposer's Service Marks and its other related trademarks, these marks identify and distinguish the restaurant services and related products and services offered by Opposer.

8. Applicant filed the Starts Application on December 13, 2012 seeking registration of the mark J.J. NORTH'S COUNTRY BUFFET (the "Starts Mark").

9. The Starts Application requests registration of the Starts Mark for services in International Class 43 identified as restaurant services.

10. The Starts Application was published in the Official Gazette of the United States Patent and Trademark Office on May 28, 2013.

11. Opposer established lawful use of Opposer's Service Marks for services in International Class 43 in commerce prior to the filing date of the Starts Application.

12. The Starts Mark as applied to services in International Class 43 is confusingly similar to Opposer's Service Marks in appearance, sound and meaning.

13. The International Class 43 services identified in the Starts Application are closely related to the services sold by Opposer under Opposer's Service Marks.

14. Applicant's application to register the Starts Mark is without the consent of Opposer.

15. The Starts Mark, as used for the International Class 43 services identified in the Starts Application, so resembles Opposer's Service Marks as to be likely to cause confusion, to cause mistake, or to deceive with respect to the source or origin of Applicant's services in International Class 43, with respect to Opposer's sponsorship thereof or affiliation or connection therewith, and/or in other ways, with resulting damage to Opposer and to the goodwill associated with Opposer's Service Marks.

16. The Starts Mark falsely suggests the existence of a connection, sponsorship or affiliation between Applicant's services in International Class 43 and the services provided by Opposer.

17. Applicant has ceased its use in commerce of the Starts Mark without intent to resume such use, has therefore abandoned the mark, and is not entitled to registration under Section 1(a) of the Lanham Act (15 U.S.C. § 1051(a)).

18. Opposer would be damaged by registration of the Starts Mark in International Class 43 in that such registration would be in derogation of Opposer's rights under the trademark laws of the United States.


WHEREFORE, Opposer prays that this Opposition be sustained and that the Starts Application be denied registration in International Class 43.

Dated this 14<sup>th</sup> day of October, 2014.

Respectfully submitted,

MONROE MOXNESS BERG PA

By

  
Ryan R. Palmer (MN Bar No. 0340650)  
Attorneys for Opposer  
7760 France Avenue South, Suite 700  
Minneapolis, MN 55435  
Tel: (952) 885-4386  
Fax: (952) 885-5969  
[rpalmer@mmblawfirm.com](mailto:rpalmer@mmblawfirm.com)

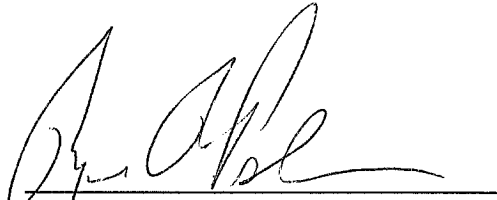


### **CERTIFICATE OF SERVICE AND MAILING**

This is to certify that I have this day served a copy of this paper by depositing said copy in the United States Mail in a properly addressed envelope with adequate postage affixed thereon to:

Steven J. Nataupsky  
Knobbe, Martens, Olson & Bear, LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614

Dated: October 14, 2014

  
\_\_\_\_\_  
Ryan R. Palmer

MMB: 4840-6900-7135, V. 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Buffets, Inc.,	)	Opposition No. 91212640
Opposer,	)	
v.	)	
STARTS CC, INC.,	)	<b><u>OPPOSER BUFFETS, INC.'S REPLY</u></b>
Applicant.	)	<b><u>BRIEF</u></b>
	)	<b><u>AND</u></b>
	)	<b><u>BRIEF IN SUPPORT OF MOTION FOR</u></b>
	)	<b><u>LEAVE TO AMEND NOTICE OF</u></b>
	)	<b><u>OPPOSITION</u></b>

**I. BRIEF IN SUPPORT OF MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

Buffets, Inc. (the "Opposer") filed a Motion to Compel Discovery and for Sanctions in this matter on September 12, 2014. In response, Applicant STARTS CC, Inc. (the "Applicant"), alleges among other things that certain discovery requested by Opposer relating to commercial use of the trademark J.J. NORTH'S COUNTRY BUFFET (the "Starts Mark"), is not relevant because abandonment was not alleged in the Notice of Opposition. Opposer accordingly requests leave of the Board to amend its Notice of Opposition, as set forth in the Amended Notice of Opposition attached to Opposer's Motion.

At the time it filed its Notice of Opposition, Opposer was not aware that abandonment of the Starts Mark might be an issue. During the course of discovery, it was revealed that the Applicant does not have an operational restaurant using the Starts Mark in commerce. Applicant's response to Opposer's First Set of Interrogatories, Interrogatory No. 3.g, states "Products or services under the mark J.J. NORTH'S COUNTRY BUFFET were available up until June of 2013, when the last remaining store, located in Scottsdale, Arizona, was closed." Applicant alleges that it intends on resuming use of the Starts Mark, but has provided no evidence in support of this allegation. Applicant further disclosed that it is in federal bankruptcy proceedings and is not offering any products or services pending resolution of those

proceedings. By way of follow up, Opposer requested information and documents regarding expenditures and actions by the Applicant relating to its intention to resume use of the Starts Mark. The Applicant states in its Opposition to Opposer's Motion to Compel that the information and documents requested by Opposer are not relevant and therefore not discoverable because abandonment was not pled in the Notice of Opposition.

Regarding amendment of pleadings, Rule 15(a)(2) of the Federal Rules of Civil Procedure ("Federal Rules") and TBMP Rule 315 provide that a notice of opposition may be amended with leave of the Board, which should be freely given when justice so requires. Under the facts presented, justice requires grant of leave to amend the Notice of Opposition. Abandonment, if proven, provides an alternate basis for refusal of registration of the Starts Mark, in addition to likelihood of confusion with Opposer's marks and the other grounds originally pled in this matter. The Applicant has stated that it currently has no operating business that uses or displays the Starts Mark, and that it is in bankruptcy proceedings. These admissions clearly raise issues of abandonment. Accordingly, Opposer requests leave of the Board to amend its Notice of Opposition to allege abandonment of the Starts Mark.

## **II. BRIEF IN REPLY TO APPLICANT'S BRIEF IN OPPOSITION TO MOTION TO COMPEL**

In its Brief in Opposition, the Applicant (a) alleges that it has fully responded to Opposer's discovery requests, and (b) raises issues of relevance of requested information and documents. With regard to completeness of the Applicant's responses, Attachments 2 and 3, letters dated June 25, 2014 and July 31, 2014 from Opposer's counsel to the Applicant's counsel, state Opposer's position that the Applicant has not fully responded and that Opposer is willing to enter into the TTAB's standard protective order or a modified order to address the Applicant's confidentiality concerns. To date, the Applicant has neither responded with respect

to the protective order nor provided the requested responses. The Applicant's arguments concerning full response are not correct.

With regard to issues of relevancy of certain of Opposer's discovery requests, the Applicant attempts to rely on a misstatement of the scope of discovery. Under Rule 26(b)(1) of the Federal Rules, discovery is proper if it "appears reasonably calculated to lead to the discovery of admissible evidence." As stated in Opposer's Brief in Support, the Federal Rules broadly favor discovery and a party opposing discovery bears the burden of showing why discovery should be denied. Tequila Centinela S.A. v. Bacardi & Company Limited., 242 F.R.D. 1 (D.C.C. 2007). Here there is no basis for denial of Opposer's discovery requests.

Opposer's requests to which the Applicant has not responded relate to expenditures made by the Applicant to resume use of the Starts Mark and all documents that relate to the Applicant's intention to resume use of the Starts Mark. Opposer's requested Amended Notice of Opposition put the question of abandonment of the Starts Mark – to which the contested discovery requests are directed – directly at issue in this case. The Applicant's actions and expenditures related to resumption of use of the Starts Mark are relevant to establishing whether or not the Starts Mark has been abandoned, and discovery directed to these matters is clearly reasonably calculated to lead to discovery of admissible evidence.

Even without amendment of the Notice of Opposition, the requested discovery falls within the scope of Rule 26(b)(1). Opposer properly alleged in its Notice of Opposition that it would be damaged by registration of the Starts Mark. The Applicant's manner and extent of use are material to that issue. Further, tangible actions and expenditures by the Applicant relating to resumption of use, or lack thereof, are material to whether Opposer would be damaged by registration of the Starts Mark. Opposer's requests are properly within the scope of discovery permitted under the Federal Rules, and the Applicant must respond to these requests.

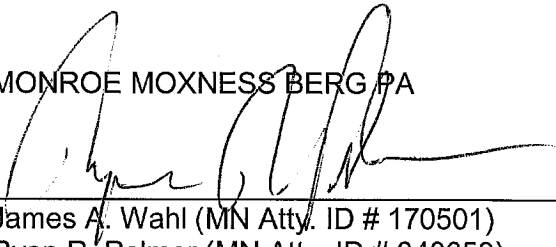
### III. CONCLUSION.

Information obtained during the course of discovery provides appropriate grounds for leave to amend Opposer's Notice of Opposition. Opposer's motion to amend should be granted as requested.

Opposer has been prejudiced in terms of pre-trial preparation and motion practice due to Applicant's failure to respond to Opposer's proper discovery requests. The Applicant's has not fully responded and has not met its burden of showing why discovery should be denied. Opposer's motion to compel and for sanctions should be granted as requested.

RESPECTFULLY SUBMITTED this 14<sup>th</sup> day of October, 2014.

MONROE MOXNESS BERG PA



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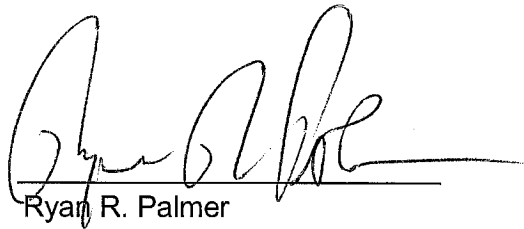
James A. Wahl (MN Atty. ID # 170501)  
Ryan R. Palmer (MN Atty. ID # 340650)  
7760 France Ave. S, Suite 700  
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Telephone: (952) 885-5999  
Facsimile: (952) 885-5969

### **CERTIFICATE OF SERVICE**

This is to certify that I have this day served a copy of OPPOSER BUFFETS, INC.'S  
OPPOSER BUFFETS, INC.'S REPLY BRIEF AND BRIEF IN SUPPORT OF MOTION FOR  
LEAVE TO AMEND NOTICE OF OPPOSITION upon Applicant by depositing said copy in the  
United States Mail in a properly addressed envelope with adequate postage affixed thereon to:

Steven J. Nataupsky  
Knobbe, Martens, Olson & Bear, LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614

This 14<sup>th</sup> day of October, 2014.



Ryan R. Palmer

MONROE MOXNESS BERG PA  
7760 France Ave. S, Suite 700  
Minneapolis, MN 55435  
(952) 885-5999

MMB: 4828-1877-6863, v. 1

## **ATTACHMENT 2**



7760 France Avenue South  
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Ryan R. Palmer  
rpalmer@mmblawfirm.com  
Direct 952.885.4386

June 25, 2014

**VIA EMAIL**

Steven Nataupsky  
Knobbe, Martens, Olson & Bear, LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614

Re: Buffets, Inc. v. Starts CC, Inc. / Discovery Responses  
TTAB Opposition No.: 91212640  
Our File No.: 13032-92

Dear Mr. Nataupsky:

With respect to Starts CC, Inc.'s responses to Buffets, Inc.'s Request for the Production of Documents and Request for Interrogatories, you objected to providing documents in response to Request Nos. 1 and 2 or to providing a response to Interrogatory No. 7 without a suitable protective order. The TTAB's standard protective order applies to all proceedings unless the parties agree to modify the standard protective order or enter into an alternative protective order. If you wish to propose a modified or alternative protective order, please promptly send a draft for my review.

In addition, you noted in your response to Interrogatory Nos. 3 and 6 that Starts CC, Inc. was investigating additional materials and would provide supplemental responses. Please provide such supplemental responses no later than July 9, 2014, as the close of discovery is quickly approaching.

Please note that Buffets, Inc. specifically reserves and does not waive any additional objections to Starts CC, Inc.'s discovery responses not specifically stated herein.

Very truly yours,

**MONROE MOXNESS BERG PA**

A handwritten signature in black ink, appearing to read "Ryan R. Palmer", written over the printed name.

Ryan R. Palmer  
Attorney at Law

RRP/WRA



## **ATTACHMENT 3**



7760 France Avenue South  
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Ryan R. Palmer  
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Direct 952.885.4386

July 31, 2014

**VIA UPS OVERNIGHT DELIVERY**

Steven Nataupsky, Esq.  
Knobbe, Martens, Olson & Bear, LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614

Re: Buffets, Inc. v. Starts CC, Inc.  
TTAB Opposition No.: 91212640  
Our File No.: 13032-92

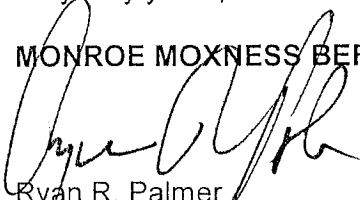
Dear Mr. Nataupsky:

Enclosed and served upon you are Opposer Buffets, Inc.'s Second Set of Requests for the Production of Documents to Applicant Starts CC, Inc. and Opposer Buffets, Inc.'s Second Set of Requests for Interrogatories to Applicant Starts CC, Inc.

I have also enclosed a copy of my letter to you dated June 25, 2014 regarding Starts CC, Inc.'s deficient discovery responses. To date, I have not received a response to the June 25, 2014 letter or the supplemental responses to Buffets, Inc.'s First Set of Requests for the Production of Documents and Interrogatories. If such supplemental responses are not received by August 13, 2014, you will leave my client with little choice but to file a Motion to Compel with the TTAB. In addition, you must provide evidence that all responses to interrogatories were answered under oath by your client.

Buffets, Inc. reserves the right to propound additional requests for the production of documents and requests for interrogatories and issue objections thereto notwithstanding the close of discovery on July 31, 2014, due to the significant delays you have caused by failing to timely respond and provide complete responses to Buffets, Inc.'s discovery requests.

Very truly yours,

  
**MONROE MOXNESS BERG PA**  
Ryan R. Palmer  
Attorney at Law

RRP/WRA/djb  
Enclosures  
MMB: 4814-9414-6844, v. 1